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SANDRA M. PARKER, ESQ.
LAW OFFICE OF SANDRA M.
PARKER
329 La Jolla Avenue
LONG BEACH, CA 90803

COPY MAILED

MAY 02 2006

OFFICE OF PETITIONS

In re Application of :
John Mark Zetts : DECISION ON PETITION
Application No. 09/850,253 :
Filed: May 7, 2001 :
Atty Docket No.STL920000106US1:

This is a decision on the PETITION FOR REVIVAL Under 37 CFR 1.137(a) filed December 23, 2005, to revive the above-identified application based on unavoidable delay.

The petition under § 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under § 1.136(a) are permitted.

BACKGROUND

The above-identified application became abandoned for failure to timely pay the issue fee and publication fee within three months of the mailing date of the Notice of Allowance and Fee(s) Due mailed June 17, 2005. This Notice set a three-month nonextendable period for response. No response having been filed, the application became abandoned by operation of law on September 18, 2005. The instant petition precedes the mailing of a courtesy Notice of Abandonment.

Consideration of Petition under § 1.137(a)

A grantable petition to revive an unavoidably abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(d).

The petition included the required reply in the form of payment of the issue fee and the publication fee¹. Payment of a petition fee is a statutory prerequisite to consideration of a petition to revive. The petition fee is being charged to Deposit Account No. 09-0460, as authorized. This utility application was filed after June 8, 1995, and thus, no terminal disclaimer is required. Requirement (3) is at issue in this case.

The burden of showing the cause of the delay is on the person seeking to revive the application. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982). Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be

¹ There was no distinct but concurrent requirement for corrected drawings. It is acknowledged that the supplemental Notice of Allowability mailed September 2005 still does not acknowledge the drawings filed September 10, 2001.

unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the entire delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner argues that the delay was unavoidable because i) there were serious errors in the Notice of Allowability, ii) given these errors that were the fault of the examiner, and based on telephone calls to the examiner and to the supervisory patent examiner, it was agreed that the applicant should not have to pay, and iii) a supplemental Notice of Allowability was mailed correcting the errors, but it was mailed after the due date for response to the original Notice and it did not restart the period for response.

Petitioner's explanation has been considered, but not found adequate to meet her burden of showing that the delay was unavoidable.

The Notice of Allowance and Fee(s) Due mailed June 17, 2005 clearly and boldly states:

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

37 CFR § 1.2 provides, in pertinent part, that:

... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

It is undisputed that no written communication was mailed to applicant restarting the period for response set in the Notice of Allowance mailed June 17, 2005. September 19, 2005 arrived with no change in the requirement to pay fees by that date or to have the application regarded as abandoned. Yet, applicant did not pay the required fees by September 19, 2005 (or file a petition to withdraw from issue pursuant to 1.313(c)(1) based on the alleged errors in the Notice of Allowability).

Further, even if the Office were to look at oral communications, petitioner acknowledges that the examiner is in disagreement as to whether it was stated that the fee had to be timely paid. Petitioner indicates that the examiner maintains that in his 8/30/05 telephone conversation, he requested the applicant to pay the issue fee. This situation illustrates the basis for the Office relying on the written record of the application. The expectations for action by the applicant and the requirements of the examiner are set forth in the written record, including any modifications or corrections. (Note: The e-mails supplied are not persuasive. Regardless, it is noted that the e-mail communications presented on petition are not part of the written record of the application).

Furthermore, the examiner does not have the authority to extend the period for response to a Notice of Allowance. The examiner stating that an applicant does not have to pay the fee required in the Notice of Allowance is not effective to avoid abandonment for failure to pay the fee within the time required by the Notice (or to invalidate the Notice). As long as the Notice of Allowance was not vacated or the application withdrawn from issue, the application was subject to abandonment for failure to timely pay the issue fee and publication fee. The statute requires, as follows:

35 U.S.C. 151 Issue of patent.

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

...

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

Conclusion

In view thereof, it is concluded that petitioner has failed to establish to the satisfaction of the Director that the delay in payment of the issue fee (and publication fee) was unavoidable within the meaning of § 1.137(a).

The showing required under § 1.137(a) is exacting, and petitioner has not met that showing. Petitioner is not precluded from providing further evidence on request for reconsideration to show that the facts and circumstances of the delay in this case warrant revival under § 1.137(a). However, petitioner is advised of an alternative venue for relief, under § 1.137(b). Petitioner may file a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under § 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 C.F.R. § 1.17(m); (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional"; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(d). (Item (4) is not required in this case).

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if

petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

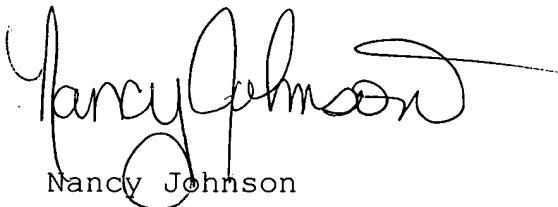
Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions